

REMARKS

Information Disclosure Statement

Applicant submits, concurrently with this Reply, an Information Disclosure Statement (IDS). Applicant requests the Examiner to indicate consideration of the listed references by returning to the applicant an initialed copy of the form 1449 accompanying the IDS.

The Office action

Claims 1 and 5 are pending. Those claims were rejected as unpatentable over the combination of:

- (1) the applicant's admitted prior art (FIG. 3),
- (2) U.S. Patent No. 5,265,177 (Cho et al.),
- (3) U.S. Patent No. 5,159,473 (Feldman),
- (4) U.S. Patent No. 5,986,782 (Alexander et al.), and
- (5) U.S. Patent No. 6,067,150 (Beller et al.).

For the reasons discussed below, applicant respectfully requests reconsideration.

The Law of Obviousness

A claimed invention is unpatentable due to obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art." 35 U.S.C. § 103(a).

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. § 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability

of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” [Citations omitted] To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness.

In re Rouffet, 149 F.3d 1350, 1357; 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998). As further explained by the Federal Circuit:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” Id.

“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

Ecolochem, Inc. v. Southern California Edison Co., 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000). The showing of the motivation to combine must be “clear and particular.” *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 63 USPQ2d 1374 at 1387 (Fed. Cir. 2002).

The Claimed Subject Matter is Patentable Over the Cited References

The pending claims were rejected as allegedly obvious from FIG. 3 of applicant’s specification in view of four additional references as well as information based on what the Office action refers to as “Official Notice.” Such an attempt to reconstruct the claimed subject matter in that way is precisely the type of improper hindsight the Federal Circuit has warned

against. Indeed, it is readily apparent that the Office action has improperly used the claimed invention itself "as a blueprint for piecing together elements in the prior art."

For example, the Office action acknowledges that applicant's disclosure of prior art in the Background section of the specification "is silent concerning a plurality of photodetectors," but then goes on to assert that the Beller et al. and Alexander et al. patents disclose multiple detectors. There is a complete failure, however, to identify the required "clear and particular" motivation to combine the references to obtain the claimed subject matter is lacking. What is clear is that there would have been no such motivation. The only motivation for doing so is found in the disclosure of applicant's invention:

When a device under test has a plurality of output terminals, photodetectors can be connected to corresponding output terminals beforehand. Hence, there is obviated a necessity of changing connections to the output terminals every time measurement is performed, thus saving labor and shortening working hours.

(Page 6, lines 7-12)

Similarly, the Office action simply asserts that "[a]s for switches, Alexander discloses switches to go between channels." Again, there would have been no motivation (other than the applicant's disclosure of the invention) for a person of ordinary skill in the art to modify applicant's FIG. 3 by adding such a switch to connect multiple photodetectors to the measurement equipment.

Furthermore, the reliance in the Office action on "Official Notice" (*see* pages 3 and 5) is misplaced. As explained by the Federal Circuit, deficiencies of the cited references cannot be remedied by general conclusions about what is basic knowledge or common sense." *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002).

In view of the foregoing remarks, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1 and 5.

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Applicant submits that the pending claims are in condition for allowance and respectfully requests such favorable action.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 5/28/04



Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, New York 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291